

REMARKS

Applicant respectfully requests reconsideration and allowance of the above-captioned application. Claims 1-20 remain pending in the application.

In the final Office Action, claims 1, 2, 5, 6, 8 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Chernow (US 4,999,608) in view of Official Notice (ON1).

As a procedural point, in making the rejections of the claims, the features of claims 2, 5, 6, 8 and 19 have not been specifically addressed. For example, claim 6 recites "(d2) requesting the user to select a seller from the article information provided in step (d1) and receiving seller information select by the user." As best understood by the Applicant, the Chernow patent does not disclose or suggest this recitation in combination with the other recitations recited in the claim. The Chernow patent is directed to purchasing and downloading software from a single seller and does not request a user to select a seller from the article information as recited in claim 6. This recitation is not specifically addressed in the final Office Action or the previous action, and apparently neither are the limitations of claims 2, 5, 8, and 19.

The Applicant requests that the finality of the present action be withdrawn, and an Office Action be issued addressing all of the features recited in all of the claims.

In regard to the rejection of the claims, independent claim 1 recites a method where a user transmits purchasing conditions together with a password during the first telephone connection in step (a) and then after the telephone connection is terminated, the server retrieves article information according to the purchasing conditions.

In contrast, in the system described in the Chernow patent, a central station accepts order information in response to a purchase request from a user (the time frame for which can be "quite lengthy", see column 6, lines 18-22 of Chernow) and transmits an acceptance key to the user during the first telephone connection. That is, the central station communicates with the user to accept the order information while the telephone connection is maintained, referring to steps (c)-(g) of Fig. 1A of the Chernow patent.

The first telephone connection is ended without retrieving the article information as recited in Applicant's independent claims, whereas the first telephone connection is maintained while the central station accepts the sales order in the system described in the Chernow patent. Due to this difference, the fee for the first telephone connection is saved by the method and system recited in the claims as compared to the system described in the Chernow patent.

Additionally, in the presently claimed method, a temporary password is transmitted from a user to an on-line shopping service. The temporary password is set by the user himself, therefore, the user benefits because the user can more easily remember the password, when asked to provide it while establishing the telephone connection in step (c) of claim 1.

In the Chernow patent, an acceptance code is transmitted from the central station to the caller. Therefore, the caller must pay close attention to acceptance code, and must either memorize or have a writing utensil to insure that the correct password can be provided to the central station during call back.

The Office asserts, "[t]he Applicant's arguments rely solely on disputing taking of Official Notice." However, on page 11, last paragraph extending to page 12, of

Applicant's arguments, Applicant states "[t]he Chernow patent does not disclose or suggest the step of receiving a temporary password and purchasing conditions from a caller/purchaser through a telephone connection as recited in claim 1. In contrast, Chernow's system initially provides the acceptance key to the caller/purchaser. It does not receive a temporary password from the user as recited in independent claim 1 and dependent claim 2."

Furthermore, at the last paragraph on page 12 that extends to page 13 of Applicant's response, Applicant states:

Additionally, the Office Action provides no motivation for why one of ordinary skill in the art would have been motivated to modify the Chernow patent in a manner to form Applicant's claimed invention. The hypothetical motivation for the modification appears to be based merely on the skill level of one skilled in the art. It has been held that the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *AI-Site Corp. v. VSI/Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

Therefore, the Office's assertion that Applicant's arguments are based "solely" on disputing the taking of Official Notice is incorrect. Applicant provided arguments regarding (1) the primary Chernow patent, (2) the sufficiency of the Official Notice and (3) the motivation to combine the Chernow patent and the explanation of Official Notice.

Even if the Office's characterization of Applicant's prior arguments were correct, the Office has not responded to Applicant's request to provide some form of evidence to support the assertion of Official Notice.

The Office's response to Applicant's arguments states prior art cited in the previous action, specifically in item U at page 5, provides an example of "user-created" passwords. However, if the Examiner is referring to the Hanania, Joseph

article entitled "Securities Insecurity....", page 5 of that article merely has footer information from the Website from which the article was obtained. Page 4, paragraph 5 of the article does refer to passwords, but merely in the context of optional safety features that a brokerage may offer, nothing more. Applicant respectfully submits that the Office has not provided sufficient evidence to support a *prima facie* case of obviousness.

The Office further asserts the step of retrieving article information meeting the purchasing conditions received in step (a), after ending the telephone connection is allegedly disclosed in Fig. 1B, steps (j, k, l). However, as pointed out above, these steps occur after the purchaser has been called (see Fig. 1B, the first step), not prior to the step of establishing a telephone connection to the user using the user's originator telephone number and confirming the user using the temporary password received in step (a) as recited in independent claims 1, 9 and 13.

Accordingly, Applicant submits that the rejections of record do not disclose how the applied prior art discloses or suggests all of the features recited in independent claims 1, 9 and 13, nor do the rejections identify the motivation for modifying the system of the Chernow patent, other than impermissible hindsight provided by Applicant's disclosure.

As for the rejection of the dependent claims 3, 4, 7, 9-18, and 20, Applicants respectfully submit that the Chernow patent, Official Notice 1, Official Notice 2, the Bernard patent, and the Chen patent, either individually or in any combination, do not disclose or suggest all of the features recited in claims 1-20.

Accordingly, Applicant respectfully requests that the Office withdraw the rejections of record for the above reasons as well as for those provided in the

previous response. Claims 1-20 are allowable, and notification to that effect is respectfully requested.

Alternatively, if the Office maintains the rejection of record, Applicant requests that evidence in support of the combination of references be provided so that Applicant can make a response to the rejections.

Should any questions arise in connection with this application, or should the Examiner believe a telephone conference would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,

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